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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,551	06/24/2002	Sunil V. Thakur		7592
7590 SUNIL V. THAKUR 18711 TIMBER TWIST DRIVE HUMBLE, TX 77346			EXAMINER LE, KHANH H	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 12/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/049,551	THAKUR ET AL.	
	Examiner	Art Unit	
	Khanh H. Le	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02/14/2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 3-5,7-19 and 23-43 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 3-5, 7-19, 23-43 is/are rejected.
- 7) Claim(s) 11, 17, 18 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>10/31/2002; 12/10/2002</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

Detailed Action

1. This Office Action is responsive to the correspondence filed 02/14/2002. Claims 3-5, 7-19, 23-43 are pending. Claims 3, 7, 12, 19, 23, 41-43 are independent.

Claims objection

2. Claims 11, 17, 18, dependent on claim 4, are objected to because a claim which depends from a dependent claim should not be separated by any claim (here, e.g. claims 7-10, 12-16) which does not also depend from said dependent claim. See MPEP § 608.01(n).

Claim rejections - 35 USC 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 3-5, 7-8, 12-15, 17-18, 23-30, 34-37, 39-40, 42-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Kepecs, US 6009411 hereinafter Kepecs.**

Kepecs discloses:

(Independent claim 23).

A business system (abstract, Figs. 1,2,3 and associated text) comprising:

a magnetic strip card with consumer identifying information encoded thereon, said information identifying a consumer desiring to conduct a transaction with a vendor (col. 7 lines 27-39);

a host system remote from the vendor location that maintains information about said vendor, (Fig. 1-3, item 11 "DAP" and associated text; col. 7 line 60 -col. 9 line 18)

an apparatus for reading the consumer identifying information on the magnetic said apparatus interconnected with and in communication with the host system for ascertaining any applicable discounts of said discounts (Fig. 2, e. g. ATM, and associated text, col. 4 lines 48-67), and

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means apart from the magnetic strip card for applying any applicable discount of said discounts related to said transaction for the benefit of said consumer (e.g. Figure 2 , items 21, 22, or 11 ("DAP") and associated text; col. 11 lines 45-55).

KEPECS also discloses (independent claim 7 and dependent claim 8):

7. A business system comprising
a magnetic strip card with consumer identifying information encoded
" thereon said information identifying a consumer desiring to conduct a transaction with a vendor,

a host system that maintains information about discounts from said vendor,
an apparatus for reading information on the magnetic strip card, said apparatus interconnected with and in communication with the host system,
means for applying any applicable discount related to said transaction for the benefit of said consumer (see citations above).

means at the host system for receiving from the vendor transaction information about said transaction (Figure 2, col. 11 lines 13-21 and 42-55);

means at the host system for storing said transaction information (col. 1 lines 46-55);

and

means for calculating a future discount for the consumer based on the transaction information and means for providing the consumer with information about the future discount. (these limitations read on targeting individual consumers with customized offers based on past purchase histories, see col. 8 lines 12-56; col. 8 line 67 to col. 9 line 2).

KEPECS also discloses (independent claim 3)

A business system comprising
a magnetic strip card with consumer identifying information encoded thereon said information identifying a consumer desiring to conduct a transaction with a vendor,
a host system that maintains information about discounts from said vendor,
an apparatus for reading information on the magnetic strip card, said apparatus interconnected with and in communication with the host system, and
means for applying any applicable discount related to said transaction for the benefit of said consumer (see citations above for claim 23),

wherein the apparatus for reading the information is located at a location of the consumer (Figure 1 item 10, consumer computer, reading consumer ID which can be typed in from consumer card, col. 7 lines 32-33).

KEPECS also discloses (independent claim 12)

A business system comprising:

a magnetic strip card with consumer identifying information encoded thereon said information identifying a consumer desiring to conduct a transaction with a vendor,
a host system that maintains information about discounts from said vendor,

an apparatus for reading information on the magnetic strip card, said apparatus interconnected with and in communication with the host system,
means for applying any applicable discount related to said transaction for the benefit of said consumer (see claim 23 above) , and

means for determining a pertinent geographic area for the consumer (col. 9 lines 34-39; col. 11 lines 4-8; col. 8 lines 19-32: targeting based on profile including zip code and purchasing histories at particular stores).

KEPECS also discloses (independent claim 42)

A business system comprising,

a magnetic strip card with consumer-identifying information encoded thereon;

a host system that maintains information about discounts from vendors;

an apparatus for reading information on the magnetic strip card, the apparatus in communication with the host system and a payment processing system, the apparatus capable of initiating **a real-time communication** link with the host system and initiating a communication link to the payment processing system (Figure 2, col. 11 lines 20-21);
and

wherein the host system maintains information about discounts from vendors and applies such discount on an itemized basis for the benefit of a consumer when the consumer purchases a discounted item at a vendor using the magnetic strip card (citations above).

KEPECS also discloses (independent claim 43)

A method for carrying out a purchase comprising the steps of:

reading at a point-of-sale terminal located at a vendor consumer-identifying information encoded on a device having a readable data string;

maintaining a database of discounts available at the vendor; determining on a real-time basis whether the items purchased by the consumer are items offered at a discount by the vendor; and

transmitting a signal to the vendor to cause a discount to such items purchased by the consumer on an itemized basis that are identified in the database as being offered by the vendor at a discount (citations above).

Kepecs also discloses the following dependent claims:

4, 26: comprising a computer at the location of the consumer for the consumer to communicate with the host system (see independent claim 3);

15, 34, 37: means for automatically determining the pertinent geographic area based on information about a consumer (col. 9 lines 34-39; col. 11 lines 4-8; col. 8 lines 19-32: targeting based on consumer identification, profile including zip code and purchasing histories at particular stores; see Kepecs citations for independent claims 12 above and 19, 41 below);

13, 35: means for displaying for the consumer information about the vendor for the determined pertinent geographic area (col. 7 line 60- col. 8 line 22 both geographic limitations and sellers information);

14, 36: means for displaying for the consumer information about a desired product or service available in the pertinent geographic area (col. 7 line 60- col. 8 line 22 both geographic limitations and sellers information);

17, 39: using the Internet to contact the host system (Fig. 1, item 14 and associated text);

18, 27, 40: means for automatically downloading information to the computer without a request from the consumer (Figure 1, col. 1 line 67 to col. 9 line 2); see independent claims 19, 41.

24: the apparatus for reading located at a location of the vendor (Fig. 2, item 27: ATM reader, and associated text);

25: see independent claim 3;

28, 29-30: see independent claim 7 and dependent claim 8 above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 19 and 41 are rejected under 35 USC 103(a) as unpatentable over Kepcs in view of Ferguson et al., US 5991736 A.**

KEPECS discloses (independent claims 19 and 41):

A business system comprising

a magnetic strip card with consumer identifying information encoded thereon said information identifying a consumer desiring to conduct a transaction with a vendor at a vendor location, a host system remote from the vendor location that maintains information about discounts from said vendor,

an apparatus for reading the consumer identifying information on the magnetic strip card, said apparatus interconnected with and in communication with the host system for ascertaining any applicable discount of said discounts,

means apart from the magnetic strip card for applying any applicable discount of said discounts related to said transaction at the vendor location for the benefit of said consumer (citations above, see independent claim 23),

a computer at the location of the consumer for the consumer to communicate with the host system ((Fig. 1 and associated text),

means for automatically downloading information to the computer without a request from the consumer (Figure 1, col. 1 line 67 to col. 9 line 2);

means at the host system for receiving from the vendor transaction information about said transaction (Figure 2, col. 11 lines 13-21 and 42-55);

means at the host system for storing said transaction information (col. 1 lines 46-55);

means for determining a pertinent geographic area for the consumer, and means for automatically determining the pertinent geographic area based on information about a consumer to contact the host system (col. 9 lines 34-39; col.11 lines 4-8; col. 8 lines 19-32: targeting based on consumer identification, profile including zip code and purchasing histories at particular stores).

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Kepecs does not but Ferguson does disclose means for calculating an amount of a retirement account contribution for a consumer based on a transaction information (abstract, Figure 1 item 30 and associated text). It would have been obvious to one skilled in the art at the time the invention was made to add Ferguson's teaching to K. to encourage patronizing sellers by fulfilling customers retirement security needs (Ferguson, col. 3 lines 28-33).

7. Claims 9, 10, 31, 32 are rejected under 35 USC 103(a) as unpatentable over Kepecs as applied to claims 7 or 23 above, and further in view of Ferguson.

The system of Kepecs/ Ferguson, as discussed for claims 19 and 41 above, also discloses (dependent claims 9, 10, 31, 32) (citations above).

8. Claims 16 and 38 are rejected under 35 USC 103(a) as unpatentable over Kepecs as applied to claims 15 or 37 above and further in view of Official Notice.

Dependent claims 16, 38:

Kepecs does not disclose the information about the consumer includes a phone number used by the consumer to contact the host system. However use of phone numbers to contact the host system as consumer identifiers are well-known at the time of the invention. One skilled in the arts would have known to add such additional form of identifiers to Kepecs at least as redundant identification means.

9. Claims 11, 33 are rejected under 35 USC 103(a) as unpatentable over Kepecs as applied to claims 4 or 26 in view of Scroggie, US 5970469.

Dependent claims 11, 33:

Kepecs does not disclose but Scroggie does, means for providing the consumer with a physical coupon in a transaction with the vendor (Figure 11 and accompanying text) One skilled in the arts would have known to combine Scroggie's teaching to Kepecs's to provide a physical means for consumers who might be more comfortable with the more familiar physical coupons in addition to providing e-coupons.

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fano, US 6317718 , Lawlor US 5870724 and Kolls US 6609102 disclose e-commerce, smart cards, location-based ads/offers.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 20, 2007

Khanh H. Le

DONALD L. CHAMPAGNE
PRIMARY EXAMINER